

Appl. No. 10/048,082.
Atty. Docket No. 7691
Amdt. dated September 23, 2003
Reply to Office Action dated September 8, 2003
Customer No. 27752

REMARKS

The Examiner has required restriction as to Claims 1-25 (Group I), Claim 26 (Group II), and Claims 27-29 (Group III) because the inventions are distinct. Further, the Examiner requires election of one species of the claimed invention out of four if Applicants elect Group I.

For the purpose of compliance with the election request and to expedite prosecution, Applicants elect, with traverse, Group I, encompassing Claims 1-25. Pursuant to this election, Applicants elect, with traverse, Species D, encompassing Figs. 16-17. With this election, Applicants believe instant Claims 1-5, 8-18 and 20-25 to be readable thereon.

Applicants traverse the instant election requirement with respect to Groups I and II insofar as the International Examining Authority recognizes that the present invention possesses unity. No unity of invention objection was raised by the International Examiner with respect to Groups I and II. Applicants respectfully assert that the instant restriction requirement therefore is improper under PCT Article 27, Para. (1), wherein it is stated that no national law may require compliance with requirements relating to international applications that are different from or in addition to those provided for in the PCT.

Applicants further submit that the restriction requirement is improper in light of PCT Rule 13.2. According to Rule 13.2, unity of invention exists when "there is a technical relationship among those inventions involving one or more of the same or corresponding technical relationship among those inventions involving one or more of the same or corresponding special technical features." Thus, restriction is proper only when the restricted groups do not share a common technical feature that defines the invention's contribution over the prior art. In line with this argument, independent Claims 1 and 22 are directed toward a novel and unobvious microvalve. Additionally, independent Claim 26 is directed towards a novel and unobvious fluid-breathing voltaic battery, comprising, *inter alia*, a microvalve. As such, the technical feature that links all of the Claims is a microvalve. Thus, Groups I and II both share a common technical feature and restriction is improper.

Applicants respectfully further submit that the Claims of Groups I and II are so closely interrelated and in order to preserve unity of invention, both groups should be prosecuted in the same application. Examination would be simplified and duplicate searching eliminated by pursuing one application as opposed to two or more applications. The inventive concept of the broad, genus claim is embodied in all claims dependent thereon as well as the exemplary embodiments shown. While it is true that each species embodied in the application carries novel

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and unobvious features, it is nonetheless true that all species disclosed are linked by the genus claims.

Further, the Applicants also traverse the restriction requirement with respect to the selection of species of microvalve. The Examiner has provided no guidance as to which claims represent the individual species.

Further, Applicants assert that the Examiner's restriction requirement is improper in light of M.P.E.P. §§802.01, 803, and 806. "There are two criteria for a proper requirement for a restriction between patentable distinct inventions: 1) Inventions must be independent ... or distinct as claimed; and 2) There must be a serious burden on the Examiner if a restriction is not required...."

M.P.E.P. §802.01 defines "independent" as "having no disclosed relationship between the two or more subjects disclosed; that is, they are unconnected in design, operation, or effect...." Applicants respectfully submit that there is a disclosed relationship among the claims of Groups I and II. Namely, each limitation utilizes the same novel and unobvious microvalve. Thus, the microvalve and method claims should never have been restricted from the apparatus claims, much less restricted to individual species of microvalves, as the Examiner has done. Thus, at a minimum, the subject of the instant groups do not meet the standard of an "independent" invention, as required by M.P.E.P. §802.01, for a proper restriction requirement.

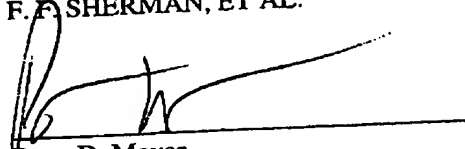
A second criterion, which must be met pursuant to M.P.E.P. §803, requires a show of burden on the Examiner for restriction to be required. In this instance, since the present claims are directed towards microvalves, searching the art would necessarily involve the body of art classified under Class 137, Subclass 625.3; Class 429, Subclass 27; and Class 29, Subclass 890.10. Applicants respectfully assert that the Examiner can, and in fact should, be able to search the present invention without serious burden. The instant groups should not be restricted, much less even further restricted to four different species of microvalves. Having the Examiner perform the same search seven or more times will lead to the same inevitable and ultimate conclusion: The apparatus is novel and unobvious and thus so are the microvalves. Therefore, the novel and unobvious microvalve apparatus and methods thereof will be, as a matter of law, novel and unobvious and will not require further restriction other than what will be performed under the instant case.

Therefore, as required by M.P.E.P., the instant groups are not independent inventions. Prosecuting the present invention without the Examiner's restriction does not impose a burden upon the Examiner. As such, neither of the two necessary criteria for the Examiner to establish

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the merited restriction requirement has been met. Thus, the restriction requirements, as presented, would be improper under current M.P.E.P. guidelines.

Respectfully submitted,
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